

CERTIFICATE OF TRANSMISSION PURSUANT TO 37 CFR § 1.8

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Date 10/14/08

Signature 

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Gregory M. Podsakoff et al.

Serial No.: 10/092,454

Filed: March 5, 2002

Patent No. 7,238,674

Grant Date: July 3, 2007

Title: METHODS FOR DELIVERING DNA TO MUSCLE CELLS USING
RECOMBINANT ADENO-ASSOCIATED VIRUS VECTORS

REQUEST FOR RECONSIDERATION OF PETITION UNDER 37 CFR §1.182

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Request for Reconsideration of Petition under 37 CFR §1.182 is being filed in response to the Decision on Petition mailed September 26, 2008 ("the Decision") in the above-referenced application. The Office dismissed applicant's Petition under 37 CFR. §1.182, filed July 18, 2008 ("the Petition"). However, Patentee submits the Office's dismissal of the Petition was in error.

Statement of Facts

Applicants submitted a corrected Terminal Disclaimer (appended) and Petition under 37 C.F.R. §1.182 on July 18, 2008 in order to correct typographical errors in the Terminal Disclaimer originally filed on December 18, 2003 (appended). The original Terminal Disclaimer was submitted in order to disclaim term over U.S. Patent Nos. 5,858,351; 6,325,998; 5,846,528; and 6,335,011. All of these patents are listed in paragraph 4 of the original Terminal Disclaimer. However, paragraph 6 of the original Terminal Disclaimer contained typographical errors. In particular, paragraph 6 listed U.S. Application No. 10/092,454 (the application that matured into

the instant patent) but did not list the patent numbers referred to above. Despite this inadvertent error, the Patent Office accepted the Terminal Disclaimer.

The Patent Office dismissed the Petition filed July 18, 2008, stating: "Once a patent issues, the USPTO will not remove the effect of a recorded terminal disclaimer." However, both the original and corrected Terminal Disclaimers listed the same patents in paragraph 4. The corrected Terminal Disclaimer merely corrected the error in paragraph 6. Thus, patentee submits the corrected Terminal Disclaimer does not remove the effect of the recorded Terminal Disclaimer as all of the same patents are listed in both documents.


Additionally, the corrected Terminal Disclaimer names the current assignee in paragraph 2 as Genzyme Corporation. Avigen, Inc., listed as the assignee in paragraph 2 of the original Terminal Disclaimer, assigned all rights in the instant patent, as well as all the patents listed in the Terminal Disclaimer, to Genzyme Corporation by way of an assignment recorded with the United States Patent and Trademark Office on September 13, 2006 at Reel 018239, Frame 0292.

Since the corrected Terminal Disclaimer disclaims term over all of the same patents as the original Terminal Disclaimer, a favorable ruling on the Petition is requested.

The Commissioner is hereby authorized to charge to Deposit Account No. 18-1648 any fees under 37 C.F.R. §§ 1.16, 1.17 and 1.21 which may be required by this paper.

Respectfully submitted,

Date: 10/14/08

By: 
Roberta L. Robins
Registration No. 33,208
Attorney for Applicant

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Letters Patent of:

Gregory M. Podsakoff et al.

Serial No.: 10/092,454

Filing Date: March 5, 2002

Patent No.: 7,238,674

Grant Date: July 3, 2007

COPY

Title: METHODS FOR DELIVERING DNA TO MUSCLE CELLS USING
RECOMBINANT ADENO-ASSOCIATED VIRUS VIRIONS

TERMINAL DISCLAIMER UNDER 37 C.F.R. §1.321(b)

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

1. I, Roberta L. Robins, state that I am an attorney of record in the above-captioned application and am a representative authorized to sign this document on behalf of Genzyme Corporation and Johns Hopkins University, the co-assignees for this invention.

2. Assignee Genzyme Corporation. is a corporation, having a place of business at 500 Kendall Street, Cambridge, MA 02142.

3. Assignee Johns Hopkins University is a university, having a place of business at 720 Rutland Avenue, Baltimore, MD 21205.

4. The co-assignees are the owners of the entire right, title and interest in the invention disclosed and claimed in the above-captioned patent, U.S. Patent No. 7,238,674 (U.S. Serial No. 10/092,454), filed March 5, 2002 and issued July 3, 2007, by virtue of assignments recorded July 31, 2003 at Reel 013842, Frames 0787 and 0754; and September 13, 2006 at Reel 018239, Frame 0292, and are also the co-owners of the entire right, title and interest in:

U.S. Patent No. 5,858,351, by virtue of assignments recorded May 20, 1996 at Reel 7946, Frame 0394; June 17, 1996 at Reel 8003, Frame 0088; and September 13, 2006 at Reel 018239, Frame 0292;

U.S. Patent No. 6,325,998, by virtue of assignments recorded May 5, 1997 at Reel 8493, Frame 0569; May 8, 1997 at Reel 8493, Frame 0150; and September 13, 2006 at Reel 018239, Frame 0292;

U.S. Patent No. 5,846,528, by virtue of assignments recorded April 29, 1997 at Reel 8473, Frame 0861; December 3, 1998 at Reel 9613, Frame 0137; and September 13, 2006 at Reel 018239, Frame 0292; and

U.S. Patent No. 6,335,011, by virtue of assignments recorded April 29, 1997 at Reel 8473, Frame 0861; December 3, 1998 at Reel 9613, Frame 0137; and September 13, 2006 at Reel 018239, Frame 0292.

5. In accordance with 37 C.F.R. §3.73(b), the undersigned hereby certifies that the evidentiary documents with respect to the assignees' ownership have been reviewed and that, to the best of her knowledge and belief, title is in the assignees seeking to take this action.

6. The assignees hereby disclaim the terminal part of U.S. Patent No. 7,238,674 which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §§ 154-156 and 173 of U.S. Patent Nos. 5,858,351; 6,325,998; 5,846,528; and 6,335,011, except as provided below, and agrees that U.S. Patent No. 7,238,674 will be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to U.S. Patent Nos. 5,858,351; 6,325,998; 5,846,528; and 6,335,011, this agreement to run with U.S. Patent No. 7,238,674 and to be binding upon the grantees, their successors or assigns.

7. In making this disclaimer, the assignees do not disclaim the terminal part of U.S. Patent No. 7,238,674 that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§ 154-156 and 173 of U.S. Patent Nos. 5,858,351; 6,325,998; 5,846,528; and 6,335,011, in the event that they later (a) expire for failure to pay a maintenance fee, (b) are held unenforceable, (c) are found invalid by a court of competent jurisdiction, (d) are statutorily disclaimed in whole or terminally disclaimed

under 37 CFR 1.321, (e) have all claims cancelled by a reexamination certificate, (f) are reissued, or (g) are, in any manner, terminated prior to the expiration of its full statutory term.

8. The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16, 1.17 and 1.21 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 18-1648.

Executed at Palo Alto, California

By: 

Title: Attorney of Record

Date: 7/18/08

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:
PODSAKOFF et al.

Serial No.: 10/092,454

Art Unit: 1632

Filing Date: March 5, 2002

Examiner: A. Wehbe

Title: METHODS FOR DELIVERING DNA TO MUSCLE CELLS USING
RECOMBINANT ADENO-ASSOCIATED VIRUS VIRIONS

COPY

TERMINAL DISCLAIMER UNDER 37 C.F.R. §1.321(b)

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

1. I, Roberta L. Robins, state that I am an attorney of record in the above-captioned application and am a representative authorized to sign this document on behalf of Avigen, Inc. and Johns Hopkins University, the co-assignees for this invention.

2. Assignee Avigen, Inc. is a corporation, having a place of business at 1301 Harbor Bay Parkway, Alameda, CA 94502

3. Assignee Johns Hopkins University is a corporation, having a place of business at 720 Rutland Avenue, Baltimore, MD 21205.

4. The co-assignees are the owners of the entire right, title and interest in the invention disclosed and claimed in the above-captioned application, U.S. Serial No. 10/092,454, filed March 5, 2002, by virtue of assignments recorded July 31, 2003 at Reel 013842, Frames 0787 and 0754, and are also the co-owners of the entire right, title and interest in:

U.S. Patent No. 5,858,351, by virtue of assignments recorded May 20, 1996 at Reel 7946, Frame 0394 and June 17, 1996 at Reel 8003, Frame 0088;

U.S. Patent No. 6,325,998, by virtue of assignments recorded May 5, 1997 at Reel 8493, Frame 0569 and May 8, 1997 at Reel 8493, Frame 0150;

U.S. Patent No. 5,846,528, by virtue of assignments recorded April 29, 1997 at Reel 8473, Frame 0861 and December 3, 1998 at Reel 9613, Frame 0137; and

U.S. Patent No. 6,335,011, by virtue of assignments recorded April 29, 1997 at Reel 8473, Frame 0861 and December 3, 1998 at Reel 9613, Frame 0137.

5. In accordance with 37 C.F.R. §3.73(b), the undersigned hereby certifies that the evidentiary documents with respect to the assignees' ownership have been reviewed and that, to the best of her knowledge and belief, title is in the assignees seeking to take this action.

6. The assignees hereby disclaim the terminal part of any patent granted on the above-captioned application Serial No. 10/092,454 which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §§ 154-156 and 173 of any patent granted on U.S. Application Serial No. 10/092,454, except as provided below, and agrees that any patent granted on the above-captioned application Serial No. 10/092,454 will be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to any patent granted on U.S. Application Serial No. 10/092,454, this agreement to run with any patent granted on the above-captioned application Serial No. 10/092,454 and to be binding upon the grantees, their successors or assigns.

7. In making this disclaimer, the assignees do not disclaim the terminal part of any patent granted on the above-captioned application Serial No. 10/092,454 that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§ 154-156 and 173 of any patent granted on U.S. Application Serial No. 10/092,454, in the event that it later (a) expires for failure to pay a maintenance fee, (b) is held unenforceable, (c) is found invalid by a court of competent jurisdiction, (d) is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, (e) has all claims cancelled by a reexamination certificate, (f) is reissued, or (g) is, in any manner, terminated prior to the expiration of its full statutory term.

8. The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16, 1.17 and 1.21 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 18-1648.

Executed at Palo Alto, CA.

By: [Signature]

Title: Attorney of Record

Date: 12/18/03